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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1-20 are pending in this application and have been rejected.

Examiner Interview Summary

The undersigned attorney for Applicant thanks Examiner David Shay for the courtesies extended during a telephonic interview on August 5, 2010, during which the Examiner and the undersigned attorney discussed new declarations to be filed in this application to overcome the rejections.

CLAIM REJECTIONS

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1-20 under 35 U.S.C. § 102(e), as being anticipated by Mazzei et al. (U.S. Patent No. 6,840,903). Applicants respectfully traverse this rejection in view of the remarks that follow.

Applicants note that Mazzei et al. was first published under U.S. Patent Appl. Publication No. 2003/0181789 on September 25, 2003, which is after the earliest claimed priority date of Applicants' application, October 21, 2002, the filing date of U.S. Provisional Application No. 60/419,558. As such, Mazzei et al. is available as a reference against this application under 35 U.S.C. § 102(e) because Mazzei et al. was filed in the USPTO on March 21, 2002, which is prior to October 21, 2002. However, in accordance with 37 C.F.R. § 1.131 and Manual of Patent Examining Procedure § 715, Applicants may submit a declaration to antedate a reference that qualifies as prior art under 35 U.S.C. 102(e), where the reference has a prior art date prior to Applicants' effective filing date and shows but does not claim the same patentable invention.

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With the Response to Office Action filed February 22, 2010, Applicants submitted a Declaration of Mark Gilreath Under 37 C.F.R. § 1.131 and a Declaration of Rachel Bentov Under 37 C.F.R. § 1.132 that were together intended to show that the subject matter of pending claims 1-20 was conceived of by Applicant prior to March 21, 2002 and that Applicant was diligent from prior to March 21, 2002 until constructive reduction to practice of the invention on October 21, 2002, the filing date of U.S. Provisional Application No. 60/419,558.

In the final Office Action, the Examiner commented that both paragraph 4 of the Gilreath declaration and paragraph 6 of the Bentov declaration contained incomplete sentence structures, namely without an object to which the declarant was informed. In response, Applicants points out that the objectionable paragraphs were proper in that they state that the declarant is “informed that the above-identified application ... was filed in the USPTO on April 18, 2005 as a national phase application under 35 U.S.C. § 371 of International Patent Application No. PCT/IL2003/000853” The first elliptical portion above refers to the ownership status of the application, and the second elliptical portion above refers to the filing date and priority information of the underlying PCT application. Applicant herewith resubmits new declarations of Gilreath and Bentov, each containing a paragraph similar to those discussed above.

In the final Office Action, the Examiner also commented that “there is no showing of due diligence during the period between ‘late 2001’ and February 17, 2002, nor during the period between February 17, 2002 and October 21, 2002.” In response, Applicant points out to the Examiner that, with respect to the period between ‘late 2001’ and February 17, 2002, in accordance with Manual of Patent Examining Procedure § 715.07(a), “under 37 C.F.R. § 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application).” See also MPEP § 2138.06. Accordingly, no diligence need be shown between late 2001 and any time other than just prior to March 21, 2002, the filing date of Mazzei et al., until the date of constructive reduction to practice.

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Applicant herewith submits new declarations of Mark Gilreath and Rachel Bentov, each containing a more detailed discussion of conception and the diligence that took place between just prior to March 21, 2002, the filing date of Mazzei et al., and October 21, 2002, the date of constructive reduction to practice.

Applicant herewith submits a Declaration of Rachel Bentov Under 37 C.F.R. § 1.132, wherein Ms. Bentov refers to a first draft of U.S. Provisional Application No. 60/419,558 attached as Exhibit B thereto that was prepared in February 2002 (prior to March 21, 2002) with her direct participation when she was an outside contractor and served as outside counsel to the assignee Given Imaging through a law firm that is the predecessor to the law firm of the undersigned attorney for Applicants.

Applicant herewith also submits a Declaration of Mark Gilreath Under 37 C.F.R. § 1.131, wherein Mr. Gilreath asserts that the subject matter of pending claims 1-20 was conceived of by him, as the sole inventor of this application, prior to March 21, 2002, with specific recollection to a meeting during late 2001. Mr. Gilreath also refers to the copy of the first draft application that was prepared in February 2002 and attached as Exhibit B to the Declaration of Rachel Bentov, and refers to his recollection with respect to subject matter of the pending claims that is reflected in that draft provisional application. Accordingly, Applicants assert that the subject matter claimed in the pending claims 1-20 was conceived of by the inventor hereof prior to March 21, 2002.

Applicant also contends that that the inventors, the owner of this application and their attorneys were duly diligent from just prior to March 21, 2002 to October 21, 2002, the filing date of U.S. Provisional Application No. 60/419,558, which is the date of constructive reduction to practice of this invention. Exhibit A attached to the Declaration of Rachel Bentov Under 37 C.F.R. § 1.132 shows a snapshot of the directory from Rachel Bentov's "old documents" directory at Given Imaging and shows that there were at least seven (7) successive draft patent applications concerning this invention that were separately saved from February through May 2002, dated February 17, 2002; February 18, 2002; April 15, 2002; April 17, 2002; April 21, 2002; May 5, 2002; and May 9, 2002. This directory evidences that Rachel Bentov was diligently drafting a patent application for the subject matter of this application all through at least February-May, 2002.

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Although Exhibit A attached to the Declaration of Rachel Bentov does not reflect any later drafts subsequent to May 9, 2002 (by that time Ms. Bentov was already employed by Given Imaging), Rachel Bentov also avers that, subsequent to the time that she joined Given Imaging, she prepared and the Applicant reviewed additional draft patent applications that were not saved on her separate directory. In this regard, Applicants note that the relevant time period within 2002 was an extremely busy one for the assignee Given Imaging (which was at the time a young company) and its few attorneys.

The Declaration of Rachel Bentov establishes that Ms. Bentov was very busy as the sole in-house patent attorney for the assignee Given Imaging Ltd. on its behalf during 2002, including during the period between March 21, 2002 and October 21, 2002. In fact, between January 1, 2002 and December 30, 2002, Ms. Bentov prepared and filed 130 separate patent applications on behalf of Given Imaging. Of these 130 applications, 62 applications were United States patent applications, almost all of which were new U.S. applications based upon original disclosures, and the rest of which were continuations, continuations-in-part, divisionals or foreign filings based upon previously-filed applications. Specifically, during the seven month period between March 21, 2002 and October 21, 2002, aside from the provisional application upon which this application is based, Given Imaging filed 81 other patent applications, of which 34 were new U.S. applications based upon original disclosures, and of which 47 were continuations, continuations-in-part, divisionals or foreign filings based upon previously-filed applications.

Accordingly, it is clear that this application was not the only application that Given Imaging was working on drafting and filing during the relevant time period between March 21, 2002 and October 21, 2002, and the attorneys for Applicant, in addition to their normal workload from other clients, clearly had a significant backlog of unrelated applications on which they worked diligently and expeditiously. As a result of this very heavy workload, it is perhaps not surprising that constructive reduction to practice of this invention, namely filing of U.S. Provisional Application No. 60/419,558, did not occur until October 21, 2002.

In accordance with MPEP § 2138.06, the diligence of the attorney in preparing and filing patent application inures to the benefit of the inventor, and reasonable diligence is all that is required of the attorney. See Bey v. Kollonitsch, 866 F.2d 1024, 231 USPQ 967 (Fed.

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Cir. 1986), which held that reasonable diligence is established if the attorney worked reasonably hard on the application during the continuous critical period, and that it is sufficient if the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously. It is clear that, in this situation, any delay during the process of preparing the provisional application until its filing on October 21, 2002 was due to the attorneys' work backlog and does not detract from Applicant's diligence in constructively reducing this application to practice.

Accordingly, Mark Gilreath has established that he conceived the invention prior to March 21, 2002, and Rachel Bentov has established that the Applicant, by virtue of her activities, was reasonably diligent between prior to March 21, 2002 and October 21, 2002, the date of constructive reduction to practice.

Thus, in view of the proofs provided in the attached Declaration of Mark Gilreath Under 37 C.F.R. § 1.131 and the attached Declaration of Rachel Bentov Under 37 C.F.R. § 1.132, Applicants argue that Mazzei et al. is no longer available as a reference against the subject patent application under 35 U.S.C. 102(e), and Applicants respectfully request that this rejections be withdrawn.

Accordingly, Applicants respectfully assert that claims 1-20 are allowable. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections to pending claims 1-20.

Conclusion

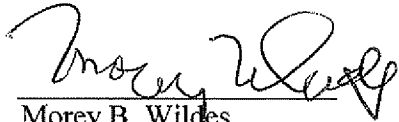
In view of the foregoing amendments and remarks, Applicants assert that the pending claims are allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Morey B. Wildes", written over a horizontal line.

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Dated: August 25, 2010

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